

REMARKS

Applicant has received and carefully reviewed the Office Action mailed on April 10, 2007. Claims 3-18 remain pending, with claims 3 and 15 amended to correct errors made in submitting the previous Amendment and Request for Continued Examination. Reconsideration and reexamination are respectfully requested.

Applicant thanks the Examiner for pointing out the mistakes made in claims 3 and 15, and also for making correct assumptions regarding the claims so that prosecution could be carried out. Claim 3 has been amended to positively recite “a mounting strip” rather than “a hinge strip” where appropriate. Claim 15 has been amended to depend from claim 1. It is believed that the claim objections stated in Paragraph 1 of the Office Action are overcome.

In Paragraph 3 of the Office Action, claims 3, 7-12, and 15-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,071,030 to Hunter et al. in view of U.S. Patent No. 4,911,777 to Truc et al. Applicant traverses the rejection on two grounds. First, Applicant believes that the asserted teachings of Truc et al. are not present in the reference. Second, Hunter et al. teaches away from any “Gap”.

The Asserted Teachings of Truc et al. are not Present

The Office Action states:

Truc et al. teaches an assembly for mounting in an album including a sheet, 12, and a hinge strip 44, spaced apart from the edge of the sheet by a gap, 50, and connected by connecting strips thereto. See column 4, lines 1-16 and Fig. 6 in particular.

However, Applicant believes these statements are inaccurate. If element 44 is the hinge strip, then it is clearly not separated from the sheet 12 by a “gap”, since Figure 6 clearly shows that element 44 is indeed coupled to the sheet 12 and overlaps the sheet 12.

Further, the embodiment shown by Truc et al. in Figures 5-6 is for a hanging file folder type of embodiment. Thus, the citation to Truc et al. is incorrect in its assertion of what is shown in Figures 5-6. Applicant directs the Examiner's attention to Figures 7-8, which do show an embodiment for mounting in an album. One of skill in the art looking to determine what would be known from the disclosure of Truc et al. would look to the ring-binder embodiment in Figures 7-8 for teaching regarding an assembly for mounting a sheet into an album. In that embodiment, Truc et al. show no gap at all. In fact, no separate mounting strip is even shown. Instead, the layered edge member 60 having openings 62 overlaps the sheet 12.

Hunter Teaches Away from any "Gap"

Applicant has previously presented this line of reasoning in the RCE filed on February 22, 2007, and requests that a response to this argument be provided, as this argument applies to any combination that relies upon Hunter et al. as a primary reference. Hunter et al. disclose a folding line or score line, which is described as follows:

The binding edge region 114 has a folding portion 120 which has spaced ring apertures 122. The binding edge region 114 may also have a non-folding portion 124. The folding portion 120 and non-folding portion 124 are separated by a folding line 126, about which the folding portion may fold. Longitudinal folding line 126 is inset from and runs parallel to the binding edge 112. In the embodiment of FIG. 5, the folding line 126 is scored to improve the regularity and proper positioning of the fold. Such scoring may consist of notches, cuts or a single indented line as best shown in FIG. 6.

(Hunter et al. at column 6, line 63 to column 7, line 6, emphasis added.) In Figure 6, the folding line can also be a line of indentation. (Hunter et al. at column 7, lines 13-15.) Thus, Hunter et al. do not teach a "gap" as is recited, as the Examiner has acknowledged by relying upon Truc et al. to show a "gap". However, in addition to the above, Hunter et al. provide additional arguments that teach away from replacing their specific folding line embodiment.

In particular, much of the background section of Hunter et al. is directed toward explaining problems, particularly with “skew” and jamming in printers, with the prior art. As explained in the above quotation, Hunter et al. teach a specific longitudinal folding line to improve the regularity and proper positioning of the fold. If a rejection similar to that already stated is to be maintained in reliance on Hunter et al., Applicant notes that providing a gap in place of the “folding line” in Hunter et al. would undermine the regularity and proper positioning of the fold within the dimensions of the gap. Specifically, the “regularity” would be compromised by the width of the gap.

In light of the above amendments and arguments, it is believed that the §103(a) rejections relying upon Hunter et al. as a primary reference, with Truc et al. as a secondary reference cited to show a “gap,” are overcome. Thus the rejections stated in part 3 of the Office Action are clearly overcome. Further, the rejections in parts 4 and 5 also should be withdrawn, as they rely upon the rejections as stated in part 3, with added references relied upon merely to show characteristics of the paper.

In addition to the above, Applicant notes again that claims 17 and 18 have not been given due patentable weight. Applicant has previously submitted evidence illustrating that “photo-grade” is a term of art having meaning to those of skill in the art, and such evidence cannot be ignored. “Photo-grade” does define structure, as set forth in the §1.132 Declaration of Paul Mott.

These claims provide further patentable, and useful, distinctions. Hunter et al., for example, teach an “index divider sheet,” which would not be considered a worthy material for printing photos, as clearly evidenced by the §1.132 Declaration. Truc et al. merely show slide sleeve material, “in the form of acetate or clear plastic [for storing] photograph slides.” The

Patent Office is obligated to at least address the submitted evidence, including the §1.132 Declaration of Paul Mott. Furthermore, the Office is obligated to respond, at some point in time, to this argument. The same language has been used repeatedly in this regard, and the mere statement that "Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection," does not appear to apply. There is no new ground for the rejection of claims 17-18, particularly here where the "new" reference, Truc et al., teaches the use of something other than paper. Applicant requests that these claims be given fuller consideration.

Reconsideration and reexamination are respectfully requested. It is believed that all pending claims, namely claims 3-18, are in condition for allowance, and issuance of a notice of allowance in due course is respectfully requested. The undersigned attorney is ending representation of the Applicant as of July 1. If a telephone conference would be of assistance, please contact Jason Burgmaier at 612-677-9050.

Respectfully submitted,

John Ratzloff

By his Attorney,

Date: 6-29-2007



Mark R. Schroeder, Reg. No. 53,566
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, MN 55403-2420
Telephone: (612) 677-9050
Facsimile: (612) 359-9349